

REMARKS/ARGUMENTS

The examiner is thanked for the thorough explanation of the remaining issues as set forth in the most recent office action. Reconsideration in view of the remarks below is respectfully requested.

Claims 1,3 and 14-28 stand rejected by the examiner as allegedly obvious over Labrie '720, Labrie '201 and the statement at specification page 2, lines 3-4. The examiner alleges that Labrie '720 and the specification disclose use of estrogens for treating menopause, and that Labrie '201 discloses the use of compounds within the scope of, *inter alia*, claim 1 against breast cancer. The Examiner relies upon *In re Kerkhoven* 626 F2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) for the proposition that it would be obvious to combine the compounds Labrie '201 uses against breast cancer with the estrogens the other two references use for menopause. However, *Kerkhoven* specifically requires that combining agents used in the prior art only creates a *prima facie* case of obviousness when the prior art's individual use of such agents is for the same purpose. Because, breast cancer and menopause are entirely different conditions with different etiologies, *Kerkhoven* does not apply to create *prima facie* obviousness over the cited references. The '201 reference also discloses other diseases at page 9, final paragraph. But all are expressly diseases "whose onset or progress is caused or enhanced by estrogen activity." Menopause is not a such a disease, and is not disclosed by the '201 reference. Because the '201 reference treats different diseases than the remaining references, *Kerkhoven* does not apply to justify combining the references to establish obviousness. Accordingly, it is urged that the rejection of claims 1,3 and 14-28 should be withdrawn.

Claim 2 stands rejected as allegedly obvious over Labrie '720, Labrie '460 and Labrie '201. However, claim 2 depends from claim 1 and incorporates all of claim 1's limitations that distinguish Labrie '201 and Labrie '720 for the reasons given above. Labrie '460 does not add any basis for combining Labrie '201 with Labrie '720. Hence claim 2 is unobvious for the same reason as claim 1 - - namely, that there is no teaching to combine estrogen with the specific compounds recited in claim 1 (and incorporated by reference into claim 2 by reason of dependency). Accordingly, it is urged that the rejection of claim 2 should be withdrawn.

It is urged that the application is now in condition for allowance. Issuance of a notice of allowance is solicited.

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Respectfully submitted,



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